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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,461	02/20/2001	Masahiro Nozaki	P 277124 T36-129082M/AIO	5463

909 7590 05/23/2002

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EXAMINER

STRIMBU, GREGORY J

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 05/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/785,461

Applicant(s)

NOZAKI, MASAHIRO

Examiner

Gregory J. Strimbu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1 + 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

Applicant's election with traverse of restriction requirement in Paper No. 4 is acknowledged. The traversal is on the ground(s) that subject matter of all of the species is sufficiently related that a thorough search for the subject matter of any one species would necessarily encompass a search for the remaining species. This is not found persuasive because the allegations listed above show that the applicant has not analyzed the examiner's action in the context of the established practice for requiring an election of species as set forth in chapter 800 of the MPEP. It is a well established practice that a requirement to elect a single species is a holding by the examiner that the plural species, as claimed, are patentably distinct (i.e., capable of supporting separate patents). See MPEP 808.01(a) and MPEP 809.02(a). If the applicant is of a different view, the applicant need merely clearly state on the record that the species are not patentably distinct. Neither the examiner nor the applicant needs to present any reasoning. Of course, it should be noted that the species that are not patentably distinct are obvious in view of one another. Applicant's response implies that the various species are not considered to be patentably distinct. If this is the case, then the applicant must clearly admit such on the record. The requirement is still deemed proper and is therefore made FINAL.

Claims 6 and 7 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4.

### ***Drawings***

Figures 11 and 12 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to because the superfluous lettering should be removed from the drawings. For example, see figure 1, wherein the superfluous lettering "car interior" and corresponding Japanese character should be removed. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

The abstract of the disclosure is objected to because "fitted to" on line 5 and "is held to be able to" on line 9 are grammatically awkward and confusing. On line 11, "in a common component" is confusing since it is unclear whether the applicant is referring to how the flange and the groove are formed, i.e., in the same machine, or is the applicant attempting to set forth that the flange and the attachment groove comprise one homogeneous element.

Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 112***

Claims 1-5, 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "formed on a window frame" on line 3 of claim 1 render the claims indefinite because they are grammatically awkward and confusing since it appears that the flange is an integral component of the window frame rather than being formed on the window frame. Recitations such as "like" on line 4 of claim 1 render the claims indefinite because it is unclear how much like a channel an element must be before it can be properly characterized as "channel like". Recitations such as "provided outward" on line 4 of claim 1 render the claims indefinite because it is unclear what the applicant is attempting to set forth. Recitations such as "circumferential side" on line 5 of claim 1 render the claims indefinite because it is unclear how a groove can have a circumference. Recitations such as "in a common component" on lines 13-14 of claim 1 render the claims indefinite because it is unclear what the applicant is attempting to set forth. Is the applicant referring to how the part of the flange and the part of the groove are formed, i.e., in the same machine, or is the applicant attempting to set forth that the part of the flange and the part of the attachment groove comprise one homogeneous element. Recitations such as "means" on line 3 of claim 3 render the claims indefinite because the applicant has attempted to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the words preceding or following "means," it is impossible to determine the

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equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Recitations such as "or" on line 10 of claim 3 render the claims indefinite because it is unclear which one of the two non-equivalent alternatives the applicant is attempting to positively set forth. Recitations such as "said first-mentioned lock protrusion strips" on line 13 of claim 3 render the claims indefinite because they lack antecedent basis. Recitations such as "said locking means is covered with the part of said trim" on lines 15-16 of claim 3 render the claims indefinite because it is unclear how the part of the trim can cover both the locking means. Recitations such as "a part of said trim" on line 16 of claim 3 render the claims indefinite because it is unclear if the applicant is referring to the part of the trim set forth above or is attempting to set forth another part of the trim in addition to the one set forth above.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by British Patent Publication No. 2 312 460. British Patent Publication No. 2 312 460 discloses a trim and glass run attachment structure 5 in a vehicle door comprising a flange 44B formed on a window frame of the vehicle door, a channel like attachment

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groove 44 provided outward at an outer circumferential side of the flange, a trim 54 having a substantially U shaped section and attached to the flange, and a glass run 40 formed separately from the trim, having a glass run body (not numbered, but seen in figure 3) to be attached into the attachment groove, wherein a part of the trim is in contact with the glass run when the trim is attached to the flange, wherein a part of the flange and a part of the channel like attachment groove are integrally formed in a common component.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Keeney et al. '824 and '987 and Hikosaka et al. are cited for disclosing a trim and glass run attachment structure having a trim and a glass run formed separately and engaging one another when installed in the frame of the vehicle door.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

A handwritten signature in black ink, appearing to read "Gregory J. Strimbu", with a long horizontal line extending from the end of the signature.

Gregory J. Strimbu  
Primary Examiner  
Art Unit 3634  
May 20, 2002